ATTORNEY DOCKET NO.   PATENT APPLICATION
014208.1626   USSN 10/634,635
(70-03-005)

9

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed January 29, 2008. Although, Applicant believes all claims are allowable without amendment, to advance prosecution Applicant has made clarifying amendments to Claims 1, 3, 5, 7, 9, 11, 13, and 15. At least certain of these amendments are not considered narrowing, and none is considered necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

I.   The Final Office Action is Deficient

Applicant respectfully submits that the Examiner has not responded substantively to certain arguments made by Applicant in the Response mailed October 30, 2007 (the "Previous Response"), which was a response to a non-final Office Action (the "Previous Office Action"). Because the Examiner did not consider and substantively respond to certain of Applicant's arguments presented in the Previous Response, Applicant respectfully submits that the current Office Action is deficient.

In response to Applicant's arguments from the Previous Response, the Examiner only addresses Applicant's arguments with respect to Claim 1. (Final Office Action at 8-10). However, Applicant made separate and different arguments for dependent Claims 8 and 16. Additionally, Applicant made certain separate and different arguments for independent Claims 17, 22, and 29. Claims 8, 16-17, 22, and 29 recite at least certain limitations that are different than the limitations recited in Claim 1. Applicant respectfully submits that he is entitled to a response to those arguments in this Office Action. According to 37 C.F.R. § 1.112, after a reply by an applicant to a non-final Office Action, the Application will be reconsidered and again examined. By apparently not considering certain of Applicant's arguments presented in the Previous Response, or by not providing Applicant with a sufficient explanation as to why the Examiner did not find those arguments persuasive, the Examiner did not reconsider and again examine the Application, including all arguments made by Applicant, as required under 37 C.F.R. § 1.112. Furthermore, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and *answer the substance of it*." M.P.E.P. ch. 707.07 (f)

(emphasis added). Applicant respectfully submits that, for Claims 8, 16-17, 22, and 29, the Examiner did not take note of Applicant's specific arguments or answer the substance of those separate arguments.

Thus, for the Examiner to properly make the current Office Action final, Applicant respectfully submits that the Examiner was required to have at least examined the Application in light of Applicant's Previous Response (including considering the specific arguments made in the Previous Response), and to have answered the substance of those arguments. Applicant recognizes that the Examiner is undoubtedly responsible for the examination of a large number of applications, placing inordinate constraints on the Examiner's time; however, Applicant respectfully submits that they should not be penalized for this fact and are still entitled to an examination of this Application in compliance with all applicable rules and guidelines.

For at least these reasons, Applicant respectfully submits that the Final Office Action is deficient. At a minimum, if the Examiner does not issue a Notice of Allowance or change the rejection in response to Applicant's present Response, Applicant respectfully submits that the Examiner should reissue the Final Office Action with a substantive response to Applicant's previous (and now maintained) arguments.

In sub-sections A.2, B, and C of Section II below, Applicant reiterates substantially verbatim the same arguments made in the Previous Response for Claims 8, 16-17, 22, and 29 because Examiner did not answer the substance of these separate arguments. In Sections A.1, A.3, and A.4 below, Applicant responds to the Examiner's arguments from the Final Office Action with respect to Claim 1 (as well as Claim 9), and Applicant provides further clarification to facilitate the prosecution of Claims 1 and 9.

II.   The Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

The Examiner rejects Claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2004/0044606 by Buttridge et al. ("*Buttridge*") in view of U.S. Patent 6,978,046 to Robinson et al. (*"Robinson"*). Applicant respectfully traverses these rejections.

A. **Independent Claims 1 and 9 and Their Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination**

    1. **The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 1**

At a minimum, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in Claim 1, as amended (which Applicant discusses as an example):

- in response to receiving the payment information:

  determining the checking account of the particular account holder based on the payment information from the purchase transaction; and

  retrieving, from a storage location storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, an image replacement document template associated with the checking account of the particular account holder used for the purchase transaction, the plurality of account holders comprising the particular account holder; and

- generating an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template.

The Examiner appears to acknowledge that *Buttridge* does not expressly disclose these limitations. (*See* Final Office Action at 2-3) However, the Examiner argues that *Robinson* discloses these limitations. (*See* Final Office Action at 3) Applicant respectfully disagrees.

For example, the cited portion of *Robinson* does not disclose, teach, or suggest "in response to receiving the payment information ... determining the checking account of the particular account holder based on the payment information from the purchase transaction," as recited in Claim 1 as amended. As allegedly disclosing "an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document," the Examiner relies on *Robinson*, citing Col. 2, ll. 50-62, the Summary of Invention, and the Abstract. (Final Office Action at 3) The cited portion of *Robinson* discloses the following:

ATTORNEY DOCKET NO.   PATENT APPLICATION
014208.1626   USSN 10/634,635
(70-03-005)

12

> The systems and methods according to this invention allow the scan/preparation user generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design theme of the document. According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document. In various embodiments, the template is created from a scanned input.

(*Robinson*, Col. 2, ll. 51-61). In the Final Office Action, the Examiner relies on another cited portion of *Robinson* disclosing the following:

> Once the attributes of the objects are identified, a template containing the attributes is synthesized. Once created, the template is saved in any desired template format for use with word processing software or the like. The template can then be used to create additional/replacement pages for the existing document that are visually coherent with the predetermined visual design theme of the document.

(*Robinson*, Col. 3, ll. 7-14).

However, nowhere does either of these cited portions disclose, teach, or suggest that the system disclosed in *Robinson*, in response to receiving payment information comprising a date, a payee, a dollar amount, a legal amount, and a signature, determines the checking account of the particular account holder based on the payment information from the purchase transaction. Instead, it appears that the cited portions in *Robinson* simply disclose creating a document template from a scanned input document and then using the template to create additional/replacement pages for the existing scanned input document. Furthermore, the Examiner argues that the "*Robinson* replacement image document generator can generate an image replacement document representative of a check." (Final Office Action at 9) Even assuming for the sake of argument only that this is true (which Applicant certainly does not concede), nowhere do the cited portions in *Robinson* disclose receiving the payment information of a particular transaction or determining the checking account of a particular account holder based on the payment information from the particular purchase transaction. The cited portions of *Buttridge* do not appear to make up for these deficiencies of *Robinson*.

ATTORNEY DOCKET NO.   PATENT APPLICATION
014208.1626   USSN 10/634,635
(70-03-005)

13

Additionally, nowhere does either of these cited portions of *Robinson* disclose, teach, or suggest that the system disclosed in *Robinson,* in response to receiving payment information (comprising a date, a payee, a dollar amount, a legal amount, and a signature), "retriev[es], from a storage location storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, an image replacement document template associated with the checking account used for the purchase transaction, the plurality of the corresponding account holders comprising the particular account holder," as recited in Claim 1 as amended. Rather, Applicant reiterates that the cited portions in *Robinson* simply disclose creating a document template from a scanned input document and then using the template to create additional/replacement pages for the existing scanned input document.

Furthermore, the Examiner argues that the "*Robinson* replacement image document generator can generate an image replacement document representative of a check." (Final Office Action at 9) Even assuming for the sake of argument only that this is true (which Applicant certainly does not concede), *Robinson* would still fail to disclose, teach, or suggest, in response to receiving payment information (comprising a date, a payee, a dollar amount, a legal amount, and a signature), "retrieving, from a storage location storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, an image replacement document template associated with the checking account used for the purchase transaction, the plurality of the corresponding account holders comprising the particular account holder," as recited in Claim 1 as amended. This is true at least because the cited portions in *Robinson* fail to disclose storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, including storing the pre-stored image replacement document template associated with the checking account of the particular account holder making the purchase transaction. *Buttridge* does not appear to make up for these deficiencies of *Robinson.*

Additionally, nowhere does either of these cited portions of *Robinson* disclose, teach, or suggest "generating an image replacement document representative of the check," as recited in Claim 1. Rather, Applicant again reiterates that the cited portions in *Robinson*

simply discloses creating a document template from a scanned input document and then using the template to create additional/replacement pages for the existing scanned input document. Furthermore, it does not appear that the cited portions of either *Buttridge* or *Robinson* disclose, teach, or suggest inserting any payment information into respective fields of an image replacement document template, let alone the particular payment information recited in Claim 1.

For at least these reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1. For at least certain analogous reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 9. Independent Claims 1 and 9 and their dependent claims are allowable for at least this reason.

2.   The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Dependent Claims 8 and 16

Additionally, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in Applicant's dependent claims. Applicant discusses dependent Claims 8 and 16 as examples, particularly Claim 8. At a minimum, the cited portions of the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in dependent Claim 8:

- generating an image replacement document identification section;
- generating a legal notification section; and
- generating a MICR section representative of the MICR line of the check.

For example, it does not appear that the cited portions of either *Buttridge* or *Robinson* disclose, teach, or suggest "generating an image replacement document identification section," "generating a legal notification section," or "generating a MICR section representative of the MICR line of the check," as recited in Claim 8. It does not even appear to Applicant that the Examiner has addressed with any particularity these limitations recited in Claims 8 and 16. For example, it does not appear that the Examiner has pointed to any portions of *Buttridge* or *Robinson* as allegedly disclosing these limitations recited in Claim 8.

For at least these reasons, the proposed *Buttridge-Robinson* combination does not appear to disclose, teach, or suggest each and every limitation recited in dependent Claim 8. For at least certain analogous reasons, the proposed *Buttridge-Robinson* combination does not appear to disclose, teach, or suggest each and every limitation recited in dependent Claim 16. Dependent Claims 8 and 16 are allowable for at least this reason.

3. The Proposed *Buttridge-Robinson* Combination is Improper

Applicant respectfully submits that the Examiner has not provided an adequate reason why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Buttridge* and *Robinson* in the manner the Examiner proposes. Applicant's claims are allowable for at least this additional reason.

With respect to the proposed combination of *Buttridge* with *Robinson*, the Examiner states:

> [T]he examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check. Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson for users to generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

(Previous Office Action at 3) In the Final Office Action, the Examiner further states that "one of ordinary skill in the art would have been motivated to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document." (Final Office Action at 9-10)

Applicant respectfully maintains that the Examiner's assertions still do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Buttridge* with the cited disclosure in *Robinson*; and (2)

how one of ordinary skill in the art at the time of Applicant's invention would have actually done so.

Even assuming for the sake of argument that *Robinson* discloses that its system generates an image replacement document template representative of any documents and that the replacement image document template generator can generate an image replacement document template representative of a check, as asserted by the Examiner, it is entirely unclear why supposedly reducing manual labor and human errors for users to generate additional and/or replacement pages for an existing document would lead one of ordinary skill in the art to combine these purported disclosures with the system of *Buttridge*, let alone how the combination would achieve these supposed advantages. The system in *Buttridge* scans a physical check at the point of sale and transfers the entire check's image data to a store controller. *See Buttridge* at [0011]. *Robinson* provides automated creation of a template for a page of an existing document from a scanned input. *See Robinson* at 1:31-33. Applicant respectfully asks the Examiner: Where in the system of *Buttridge* would one of ordinary skill in the art of the time of Applicant's invention even incorporate the identified teaching of *Robinson*? Applicant also respectfully asks the Examiner: How would modifying *Buttridge* in such a way even achieve a reduction in manual labor and human error?

It is unclear to Applicant why one of ordinary skill in the art would be motivated to combine the teachings of *Buttridge* and *Robinson* to reduce manual labor and human errors to generate an image replacement template representative of the original document. Isn't this combination increasing the labor and chance for error by requiring the additional step of creating an image replacement template of the entire check image? It is unclear to Applicant why creating and storing a template of a received electronic check image will reduce manual labor and human error?

Respectfully, the Examiner's attempt to combine *Buttridge* with *Robinson* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

ATTORNEY DOCKET NO.   PATENT APPLICATION
014208.1626   USSN 10/634,635
(70-03-005)

17

Accordingly, since the Examiner has not demonstrated the required teaching, suggestion, or motivation to combine *Buttridge* and *Robinson* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully submits that the proposed *Buttridge-Robinson* combination is improper. Independent Claims 1 and 9 and their dependent claims are allowable for at least this additional reason.

4.   Conclusions with Respect to Claims 1 and 9

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 1. For at least certain analogous reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 9. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1 and 9 and their dependent claims.

B.   Independent Claims 17 and 22 and Their Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

1.   The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 17

The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claims 17 and 22. Applicant discusses independent Claim 17 as an example.

At a minimum, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in Claim 17:

- generating a snippet of the payment information; and
- electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet.

The Examiner acknowledges, and Applicant agrees, that *Buttridge* does not expressly disclose these limitations. (*See* Previous Office Action at 5) However, the Examiner argues that *Robinson* discloses these limitations. (*See* Previous Office Action at 5) Applicant respectfully disagrees.

For example, the cited portion of *Robinson* does not disclose, teach, or suggest "generating a snippet of the payment information," as recited in Claim 17. As allegedly disclosing "an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document," which incidentally does not correspond exactly to the limitations actually recited in Claim 17, the Examiner relies on *Robinson*, citing Col. 2, ll. 50-62, the Summary of Invention, and the Abstract. (Previous Office Action at 5) The cited portion of *Robinson* discloses the following:

> The systems and methods according to this invention allow the scan/preparation user generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design theme of the document. According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document. In various embodiments, the template is created from a scanned input.

(*Robinson*, Col. 2, ll. 51-61)

However, nowhere does this cited portion disclose, teach, or suggest generating a snippet of any payment information [received from an output device].

Additionally, nowhere does the cited portion of *Robinson* disclose, teach, or suggest "electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet," as recited in Claim 17. The cited portion simply makes no reference to transmitting any information to a remote location, let alone "electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet," as recited in Claim 17.

For at least these reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 17. For at least certain analogous reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 22. Independent Claims 17 and 22 and their dependent claims are allowable for at least this reason.

2.   The Proposed *Buttridge-Robinson* Combination is Improper

Applicant respectfully submits that the Examiner has not provided an adequate reason why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Buttridge* and *Robinson* in the manner the Examiner proposes. Applicant's claims are allowable for at least this additional reason.

The Examiner appears to rely on the same argument discussed above with respect to Claim 1 as to why the proposed combination is proper. (Previous Office Action at 5) Applicant reiterates the argument made above with respect to Claim 1 in Section II.A.3.

Accordingly, since the Examiner has not demonstrated the required teaching, suggestion, or motivation to combine *Buttridge* and *Robinson* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully submits that the proposed *Buttridge-Robinson* combination is improper. Independent Claims 17 and 22 and their dependent claims are allowable for at least this additional reason.

3. Conclusions with Respect to Claims 17 and 22

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 17. For at least certain analogous reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 22. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 17 and 22 and their dependent claims.

C. Independent Claim 29 and The Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

1. The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 29

The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 29.

At a minimum, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in Claim 29:

- generating a snippet of the payment information;
- electronically transmitting the snippet to a remote location;
- electronically receiving the snippet at the remote location;
- in response to receiving the snippet, retrieving, from a storage location, an image replacement document template associated with the checking account; and
- generating an image replacement document representative of the check by inserting the payment information from the snippet into respective fields of the image replacement document template.

The Examiner acknowledges, and Applicant agrees, that *Buttridge* does not expressly disclose these limitations. (*See* Previous Office Action at 7) However, the Examiner argues

that *Robinson* discloses these limitations. (*See* Previous Office Action at 7) Applicant respectfully disagrees.

For at least certain reasons analogous to those stated in Sections II.A and II.B of this document, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 29. Independent Claim 29 and the associated dependent claims are allowable for at least this reason.

2.   The Proposed *Buttridge-Robinson* Combination is Improper

For at least certain reasons analogous to those stated in Sections II.A and II.B of this document, Applicant respectfully submits that the proposed *Buttridge-Robinson* combination is improper. Independent Claim 29 and the associated dependent claims are allowable for at least this additional reason.

3.   Conclusions with Respect to Claim 29

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 29. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 29 the associated dependent claims.

III.   No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

ATTORNEY DOCKET NO.   PATENT APPLICATION
014208.1626   USSN 10/634,635
(70-03-005)

22

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant
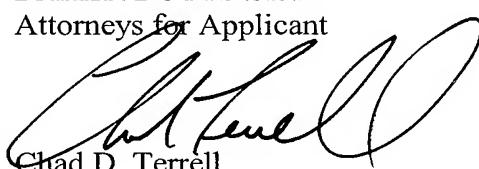
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Date: March 31, 2008

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